



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,760	06/23/2003	John F. Gullo	8049.0925	5733

22852 7590 01/30/2007
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

JABR, FADEY S

ART UNIT	PAPER NUMBER
----------	--------------

3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/600,760	GULLO, JOHN F.	
	Examiner	Art Unit	
	Fadey S. Jabr	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/18/03, 8/24/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims **30 - 58** are rejected under 35 U.S.C. § 112, first paragraph, as being of undue breadth. A "single means" claim, i.e. where a means recitation does not appear in combination with another recited element or means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. See *In re Hyatt*, 218 USPQ 195, (CAFC 1983) and MPEP 2164.08(a).

2164.08(a) Single Means Claim

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In *re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Although the court in *Fiers v. Sugano*, 984 F.2d 164, 25 USPQ2d 1601 (Fed. Cir. 1993) did not decide the enablement issue, it did suggest that a claim directed to all DNAs that code for a specified polypeptide is analogous to a single means claim.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **59 – 87** are rejected under 35 U.S.C. 101 because computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional

Art Unit: 3628

interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See MPEP § 2106 (a). In the present case, the computer program product is not embodied in a computer readable medium as discussed above.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6, 8-9, 11-14, 30-33, 35, 37-38, 40-43, 59-62, 64, 66-67, 70-72 and 88 are rejected under 35 U.S.C. 102(e) as being anticipated by Montgomery et al., Pub. No.

US2003/0101148 A1.

As per **Claims 1, 30, 59 and 88**, Montgomery et al. discloses a system and method comprising:

Art Unit: 3628

- requesting, through a communication channel, a tracking number for the mailing label, wherein the tracking number identifies that the mailing label is printable by a user on a single-sheet medium (0084, 0089-0091, also see Figures 2 and 9);
- receiving, through a communication channel, a response to the request, the response including the tracking number provided by a tracking number source (0089-0091, also see Figures 2 and 9); and
- enabling the user to print the mailing label with the received tracking number on a single-sheet medium (0089, also see Figures 2 and 9).

As per **Claims 2, 31 and 60**, Montgomery et al. further discloses requesting the tracking number through an interface which solicits a request for the tracking number from the tracking number source (0085, 0089).

As per **Claims 3, 32 and 61**, Montgomery et al. further discloses requesting the tracking number through an interface, the interface adapted to identify that the tracking number is for the mailing label that is printable by the user (0089).

As per **Claims 4, 33, 43, 62 and 72**, Montgomery et al. further discloses printing the mailing label on the single-sheet medium, wherein the single-sheet medium is useable as an Express Mail label (0082, 0168, also see Figure 2).

Art Unit: 3628

As per Claims 6, 35 and 64, Montgomery et al. further discloses enabling the user to print through an interface at a processor (0089).

As per Claims 8, 37 and 66, Montgomery et al. further discloses enabling the user to print when an image file is received (0030, 0141).

As per Claims 9, 38 and 67, Montgomery et al. further discloses enabling the user to print the mailing label when the tracking number is received (see Figure 9).

As per Claims 11, 40 and 69, Montgomery et al. further discloses requesting an acknowledgement of delivery based on the tracking number (0082, 0179-0180, also see Figure 2).

As per Claims 12, 41 and 70, Montgomery et al. further discloses receiving the requested acknowledgement (0179-0180).

As per Claims 13, 42 and 71, Montgomery et al. further discloses receiving a date with the delivery acknowledgment, such that the date corresponds to when the letter was delivered (0173, 0179-0180, also see Tables 1 and 2).

As per Claim 14, Montgomery et al. further discloses mailing a label as the single-sheet medium (see Figure 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims **7, 10, 36, 39, 65 and 68** are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al., Pub. No. US2003/0101148 A1.

As per **Claims 7, 10, 36, 39, 65 and 68**, Montgomery et al. fails to *explicitly* disclose receiving the tracking number with an indication that a credit card was charged. However, Montgomery et al. discloses a tracking ID request module configured to generate a request for a unique tracking ID where postage information is associated with the tracking ID (such as, e.g. amount of postage) (0090). Moreover, Montgomery et al. discloses using credit cards for reimbursing the postage system (0093). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Montgomery et al. and include associating postage information (financial information, etc.) with the tracking number, because it informs the postal system whether they have been reimbursed for the mail transaction.

8. Claims **5, 34 and 63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al., Pub. No. US2003/0101148 A1 in view of Sansone et al., U.S. Patent No. 6,547,136 B1.

As per Claims 5, 34 and 63, Montgomery et al. fails to disclose printing the mailing label with an indication that postage is required. However, Sansone et al. teaches printing postage due indicator on the mail piece (see Figure 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Montgomery et al. and include providing a postage due indicator as taught by Sansone et al., because it provides an indication to the postal system to obtain payment for the mail transaction.

9. Claims 15-26, 28-29, 44-55, 57-58, 73-84, 86-87, 89 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al., Pub. No. US2003/0101148 A1 in view of Reich et al., Pub. No. US2003/0093383 A1.

As per Claims 15, 23, 29, 44, 52, 58, 73, 81, 87, 89 and 90, Montgomery et al. discloses a system and method comprising:

- receiving, through a communication channel, a request for a tracking number (0084, 0089, also see Figure 9);
- determining whether the request is for a mailing label that is printable on the single-sheet medium (0084, 0089-0091, also see Figures 2 and 9);
- storing the determined tracking number (0089-0090); and
- providing, through the communication channel, the determined tracking number (0089-0091, also see Figures 2 and 9).

Art Unit: 3628

Montgomery et al. fails to disclose determining the tracking number, such that the tracking number includes a unique prefix when the request is for a mailing label that is printable on the single-sheet medium. Montgomery et al. discloses determining a tracking number that is printable on a single-sheet medium (0084). However, Reich et al. teaches generating unique encrypted prefix codes upon request from a customer, wherein the prefix is encrypted in order to allow for authentication when requested by a customer through a communications network (0029-0031, claim 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system and method of Montgomery et al. and include a unique prefix along with a franking code as taught by Reich et al., because it provides a further security layer to prevent fraud by allowing for authentication of the mail piece.

As per **Claims 16, 45 and 74**, Montgomery et al. discloses receiving the request through an interface, the interface adapted to receive the request from a user (0089).

As per **Claims 17, 46 and 75**, Montgomery et al. discloses receiving payment information corresponding to the user (0093).

As per **Claims 18, 47 and 76**, Montgomery et al. discloses receiving a credit card number for the user (0093).

As per **Claims 19, 48 and 77**, Montgomery et al. discloses receiving a ZIP code for a destination of a letter associated with the request (0033, 0090).

As per **Claims 20, 49 and 78**, Montgomery et al. discloses determining whether the request originated from an interface, the interface adapted to enable a user to print the mailing label on the single-sheet medium (0089).

As per **Claims 21, 50 and 79**, Montgomery et al. discloses providing a source database of at least one tracking number, with information identifying a user (0085, 0089-0090).

As per **Claims 22, 51 and 80**, Montgomery et al. discloses receiving a response from the source database, such that the response includes the tracking number corresponding to the user (0085, 0089-0090).

As per **Claims 24, 53 and 82**, Montgomery et al. discloses providing through an interface, the determined tracking number, wherein the interface is adapted to print the mailing label on the single-sheet medium (0089, also see Figure 2).

As per **Claims 25, 54 and 83**, Montgomery et al. discloses printing the determined tracking number on the single-sheet medium (see Figure 2).

As per **Claims 26, 55 and 84**, Montgomery et al. discloses printing an Express Mail label on a single-sheet medium, the Express Mail label including the determined tracking number (0082, 0168, also see Figure 2).

Art Unit: 3628

As per Claims 28, 57 and 86, Montgomery et al. discloses generating a mailing receipt (delivery confirmation) (0082).

10. Claims **27, 56 and 85** are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al., Pub. No. US2003/0101148 A1 in view of Reich et al., Pub. No. US2003/0093383 A1 as applied to claims 15, 44 and 73 above, and further in view of Leon, Pub. No. US2001/0042052 A1.

As per Claims 27, 56 and 85, Montgomery et al. fails to disclose generating a bill to the user, the bill derived from the stored information. However, Leon teaches billing the user for postage purchased (0109). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system and methods of Montgomery et al. and include billing a user for postage purchased as taught by Leon, because a postage supplier would require reimbursement for goods supplied to the user.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references

Art Unit: 3628

in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

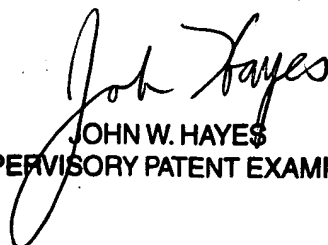
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Art Unit: 3628

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(571) 273-1516 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401
Dulany Street, Alexandria, VA 22314